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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Mark Baker

Serial No. 09/333,421

Filed: June 15, 1999

For: Smart Bookmarks for Small
Footprint Device Applications

§ Group Art Unit: 2126

§ Examiner: Hoang, Phuong N

§ Atty. Dkt. No.: 5181-31400
§ P4185

CERTIFICATE OF MAILING
37 C.F.R. § 1.8

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APPEAL BRIEF

Mailstop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

Further to the Notice of Appeal filed August 20, 2004, Appellant presents this Appeal Brief. Appellant respectfully requests that this appeal be considered by the Board of Patent Appeals and Interferences.

10/27/2004 ZJUHA1 00000017 501505 09333421

01 FC:1401 340.00 DA

Adjustment date: 10/29/2004 ZJUHA1
10/27/2004 ZJUHA1 00000017 501505 09333421
01 FC:1401 340.00 CR

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10/29/2004 ZJUHA1 00000011 501505
01 FC:1402 340.00 DA

I. REAL PARTY IN INTEREST

The subject application is owned by Sun Microsystems, Inc., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at 4150 Network Circle, Santa Clara, CA 95054, as evidenced by the assignment recorded at Reel 010249, Frame 0229.

II. RELATED APPEALS AND INTERFERENCES

This appeal is not related to any other appeals.

III. STATUS OF CLAIMS

Claims 1, 12, and 13 are pending and rejected. The rejection of claims 1, 12, and 13 is being appealed. A copy of claims 1, 12, and 13 is included in the Claims Appendix hereto.

IV. STATUS OF AMENDMENTS

In Appellant's August 20, 2004 response to the Examiner's final rejection, Appellant cancelled claims 2 – 11 and amended claims 1, 12, and 13. The Examiner's Advisory Action of October 5, 2004 indicated that the proposed amendments have been entered for the purposes of appeal. Accordingly, claims 1, 12, and 13 are under appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Various embodiments enable small footprint device users to create and store bookmarks referencing various types of objects and/or data sources (collectively referred to herein as data sources). Each bookmark may comprise a Uniform Resource Locator (URL) which may be used to refer to the object/data source. The bookmark system may be open-ended, allowing virtually any type of object or data source to be bookmarked. The bookmarks may later be used by a user or application to reference the respective data

source to perform some type of action on the data source, such as displaying or editing it. *See* specification, page 3, lines 17 – 23.

Independent claim 1 is directed to a system for creating persistent references to data sources. More particularly, a user may invoke a bookmark service on a particular data source. The bookmark service may, in turn, create a bookmark referencing the data source and store the bookmark. *See* specification, page 7, line 26 – page 8, line 13, and Fig. 2. In claim 1, the data source may be an email, which may later be referenced by the bookmark. *See* specification, page 7, lines 1 – 5.

Independent claim 12 is directed to a system for creating persistent references to data sources. More particularly, a user may invoke a bookmark service on a particular data source. The bookmark service may, in turn, create a bookmark referencing the data source and store the bookmark. *See* specification, page 7, line 26 – page 8, line 13, and Fig. 2. In claim 12, the data source may be a web page, which may later be referenced by the bookmark. *See* specification, page 7, lines 1 – 7.

Independent claim 13 is directed to a system for creating persistent references to data sources. More particularly, a user may invoke a bookmark service on a particular data source. The bookmark service may, in turn, create a bookmark referencing the data source and store the bookmark. *See* specification, page 7, line 26 – page 8, line 13, and Fig. 2. In claim 1, the data source may be an appointment entry, which may later be referenced by the bookmark. *See* specification, page 7, lines 1 – 7.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 1, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Jini Architecture Specification” (hereinafter ‘Jini’) in view of Scholoss et al. (USPN 6,249,844, hereinafter ‘Scholoss’) in further view of Baker et al. (USPN 6,430,599, hereinafter ‘Baker’).

VII. ARGUMENT

First Ground of Rejection:

Claims 1, 12, and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Jini in view of Scholoss in further view of Baker. Appellant traverses this rejection for the following reasons. Different groups of claims are addressed under their respective subheadings.

Claim 1

Claim 1 stands rejected under 35 U.S.C. § 103(e) as being unpatentable over Jini in view of Scholoss in further view of Baker. Appellant asserts that the Examiner has not established a case that the combination of Jini, Scholoss and Baker make obvious the system described in Appellant's claim 1.

In rejecting claim 1, the Examiner asserted in his Response to Arguments at number 26 on page 9 of the Final Office Action dated May 20, 2004:

“As to point 1, Jini teaches a first computing service is operable to create a persistence reference to a data source in response to a user selecting the data source in response to a user selecting the data source (lookup service, containing data source which are services, has ability to add a service to it when a client or user needs to locate and invoke a service; it is known as discovery and join...”

In the Examiner's Advisory Action of October 5, 2004, the Examiner stated “Examiner did not cite lookup service as discovery and join (see the last office action).” However, Appellant believes it clear, based on the quotation given above, that the Examiner did cite the lookup service as discovery and join.

Furthermore, Appellant respectfully notes that Jini discloses at page 12 “A pair of these protocols – discovery/join – occurs *when a device is plugged in.*”(Emphasis added) Appellant submits that discovery and join, as described by Jini, are not invoked “when a

client or user needs to locate and invoke a service,” as asserted by the Examiner, or **“in response to a user selecting said data source,”** as recited in Appellant’s claim 1.

Appellant also notes that Scholoss teaches a small footprint device which may be a smart phone or set-top box (col. 1, lines 18 – 25) However, Scholoss **does not** teach a computing service **“operable to create a persistent reference to a data source in response to a user selecting said data source,”** as recited in Appellant’s claim 1.

In addition, Appellant respectfully disagrees with the Examiner’s assertion on page 2 of the Advisory Action of October 5, 2004 that “Baker teaches an email service as an email.” Baker teaches at col. 9, lines 45 – 62:

“For example, the email client “application” 150 of the smart cellular phone shown in Fig. 3 may itself be a service to a client running in the containment framework 144 or to a network client. For example, in the case of malfunction, the printer 130 shown in Fig. 3 may request an email service so that it can send diagnostic information to a service technician. If the network lookup service 136 cannot find a network-based email service, it may request an email service from the smart cellular phone 134 via the interface 142. A service object for the email application/service 150 running in the containment framework 144 may be passed to the requesting printer client 130. **In this example, the printer client 130 may communicate directly with the email application/service 150 to send an email containing diagnostic information to a printer service technician.** The email application/service 150 may send the email immediately if it is able to find an email server service, or it may send the email later when such a service becomes available when the cellular phone user connects to a different network.” (Emphasis added)

However, Appellant can find no teaching or suggestion in Baker that **“said data source is an email”** as recited in Appellant’s claim 11. Appellant respectfully submits that an email service, as defined above by Baker, may be used to send or receive emails, but is **not** in and of itself an email. Accordingly, a bookmark of an email service is not a bookmark of an email.

For the foregoing reasons, Appellant respectfully submits that claim 1 patentably distinguishes over the cited references.

Claim 12

Claim 12 stands rejected under 35 U.S.C. § 103(e) as being unpatentable over Jini in view of Scholoss in further view of Baker. Appellant asserts that the Examiner has not established a case that the combination of Jini, Scholoss and Baker make obvious the system described in Appellant's claim 12.

In addition to the Appellant's arguments regarding claim 1, Appellant submits the following additional arguments in regard to claim 12. Appellant respectfully disagrees with the Examiner's assertion on page 2 of the Advisory Action of October 5, 2004 that "Baker teaches a data source is a web page." The Examiner further cites Baker col. 9, lines 25 – 35, which teaches:

"The containment framework 144 may integrate its own lookup service 146 with an off-device lookup service such as the local network lookup service 136 shown in Fig. 3. **In this way, off-device services such as the print service 138 and the web service 140 may become available to the applications/services 148, 150, and 152 of the containment framework, and vice versa.** For example, the personal organizer application 152 may request a print service from the containment framework lookup service 146. The containment framework lookup service 146 may first search for an on-device print service." (Emphasis added)

However, Appellant can find no teaching or suggestion in the cited portion of Baker that **"said data source is a web page"** as recited in Appellant's claim 12. Appellant respectfully notes that a web service may be used to access a web page, but that a web service in and of itself is not a web page. Accordingly, a bookmark of a web service is not the same as a bookmark of a web page.

For the reasons given above, Appellant respectfully submits that claim 12 patentably distinguishes over the cited references.

Claim 13

Claim 13 stands rejected under 35 U.S.C. § 103(e) as being unpatentable over Jini in view of Scholoss in further view of Baker. Appellant asserts that the Examiner has not established a case that the combination of Jini, Scholoss and Baker make obvious the system described in Appellant's claim 13.

In addition to Appellant's arguments regarding claim 1, Appellant submits the following additional arguments in regard to claim 13. Appellant respectfully disagrees with the Examiner's assertion on page 2 of the Advisory Action of October 5, 2004 that "Baker teaches data source as an appointment entry." The Examiner further cites Baker col. 9, lines 15 – 25, which teaches:

"As shown in Fig. 3 and described in more detail below, the containment framework 144 has its own type of lookup service 146. The lookup service 146 within the containment framework 144 may operate similarly to the local network lookup service described above, utilizing discovery, join, lookup, and service invocation processes. For example, the **personal organizer application 152 may utilize various services such as a calendar service, a contact list service, a bookmark service, etc.** (not shown). The personal organizer application 152 may obtain a reference for communicating with these services via the containment framework lookup service 146." (Emphasis added)


However, Appellant can find no teaching or suggestion in the cited portion of Baker that "**said data source is an appointment entry**" as recited in Appellant's claim 13. Appellant respectfully notes that a calendar service may be used to access an appointment entry, but that a calendar service in and of itself is not an appointment entry. Accordingly, a bookmark of a calendar service is not the same as a bookmark of an appointment entry.

For the reasons given above, Appellant respectfully submits that claim 13 patentably distinguishes over the cited references.

VIII. CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1, 12 and 13 was erroneous, and reversal of the Examiner's decision is respectfully requested.

Respectfully submitted,


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IX. APPENDIX A

The claims on appeal are as follows.

1. (Currently amended) A system for creating persistent references to data sources comprising:

- a small footprint device, wherein said small footprint device includes a processing unit and system memory;
- a software framework stored in said system memory, wherein said software framework supports program modules, wherein said program modules implement computing services;
- a first computing service implemented by one or more of said program modules, wherein said first computing service is operable to create a persistent reference to a data source in response to a user selecting said data source, wherein said data source is an email;
- a second computing service implemented by one or more of said program modules, wherein said second computing service is operable to access said data source using said persistent reference.

2 – 11 (Cancelled)

12. (Currently amended) A system for creating persistent references to data sources comprising:

- a small footprint device, wherein said small footprint device includes a processing unit and system memory;
- a software framework stored in said system memory, wherein said software framework supports program modules, wherein said program modules implement computing services;
- a first computing service implemented by one or more of said program modules, wherein said first computing service is operable to create a persistent

reference to a data source in response to a user selecting said data source,
wherein said data source is a web page;

a second computing service implemented by one or more of said program
modules, wherein said second computing service is operable to access said
data source using said persistent reference.

13. (Currently amended) A system for creating persistent references to data sources
comprising:

a small footprint device, wherein said small footprint device includes a processing
unit and system memory;

a software framework stored in said system memory, wherein said software
framework supports program modules, wherein said program modules
implement computing services;

a first computing service implemented by one or more of said program modules,
wherein said first computing service is operable to create a persistent
reference to a data source in response to a user selecting said data source,
wherein said data source is an appointment entry;

a second computing service implemented by one or more of said program
modules, wherein said second computing service is operable to access said
data source using said persistent reference.

X. EVIDENCE APPENDIX

No evidence submitted under 37 CFR §§ 1.130, 1.131 or 1.132 or otherwise entered by the Examiner is relied upon in this appeal.

XI. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

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